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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,289	10/13/2000	Robert G. Padingham	584-1033	8885

23644 7590 08/28/2006

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CHICAGO, IL 60690-2786

EXAMINER
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NGUYEN, NGA B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/688,289

Applicant(s)

PADINGHAM ET AL.

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,3,5,8-10,12,13 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,5,8-10,12,13 and 15-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 14, 2006 has been entered.
2. Claims 2, 3, 5, 8-10, 12, 13, and 15-28 are pending in this application.

### ***Response to Amendment/Arguments***

3. Applicant's arguments with respect to claims 2, 3, 5, 8-10, 12, 13, and 15-28 have been considered but are moot in view of new ground of rejection.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 2, 10, 19, 20, 25, and 26 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The claims, as presently claimed and best understood were reconsidered in light of the "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

As to claims 2, 10, 19, 20, 25, and 26, the claimed invention is implemented as Functional Descriptive Material *Per Se*. "A software agent" recited in claims 2, 10, 19, 20, and "A computer program" recited in claims 25, 26, are considered Functional Descriptive Material. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). In this case, "A software agent" recited in claims 2, 10, 19, 20, and "A computer program" recited in claims 25, 26, are not recorded on any computer-readable medium.

Therefore, for the reason set forth above, claims 2, 10, 19, 20, 25, and 26 are non-statutory, because they are directed solely to Functional Descriptive Material *Per Se*.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2, 3, 5, 8-10, 12, 13, 15-21, and 23-28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ojha et al (hereinafter Ojha), U.S. Patent No. 6,598,026, in view of Solomon, U.S. Patent No. 6,035,288.

Regarding to claims 2-3, Ojha discloses a method of performing automated reverse auction on an electronic network using a software agent for a party conducting electronic trading (figure 1 and column 8, lines 50-67, the web site at which transactions between buyers and sellers are facilitated is located on a server 102), comprising:

a store of a plurality of negotiation profiles each negotiation profile determining different negotiation characteristics and requirements (column 15, lines 30-65, the seller authorizes automated response to bids by specifying a number of business rules to govern the responses, for each rules, the seller defines a set of criteria and set of actions to be taken when the set of criteria is satisfied, the number of criteria may be defined and combined in variety of ways using logical operators and groupings);

a transaction engine responsive to the commercial situation or state of the party to select an optimal negotiation profile appropriate to that situation or state (column 9, lines 15-18, a series of graphical user interfaces which will be used to illustrate the transaction process);

a negotiation engine driven by the transaction engine that is able to generate bids and counter bids (figures 15-17 and column 18, lines 30, a series of graphical user interfaces allow buyers and sellers submit bids and counteroffers); and

means adapted to cause the transaction engine to initiate or conduct e-commerce negotiations using the negotiation engine programmed with the selected negotiation profile (figures 13A-13K and column 15, line 30-column 16, line 67, the business rules associated with each seller is equivalent to negotiation profiles, the seller authorizes automated responses to bids by specifying a number of business rules to govern the responses).

Ojha does not disclose a mapping for converting qualitative attributes for a part of a bid into numerical values and a weighting factor for each part of a bid and compute a single value for a bid by adjusting the numerical value using the weighting factor and summing the adjusted values, the single numerical value being used to determine whether to accept the bid or not. However, Solomon discloses a mapping for converting qualitative attributes for a part of a bid into numerical values and a weighting factor for each part of a bid and compute a single value for a bid by adjusting the numerical value using the weighting factor and summing the adjusted values, the single numerical value being used to determine whether to accept the bid or not (see figure 4 and column 4, line 33-column 5, line 35). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ojha's to adopt the teaching of Solomon above for the purpose of providing more efficiency in performing automated reverse auction.

Claim 5 contains similar limitations found in claims 2-3 above, therefore, are rejected by the same rationale. Moreover, Ojha further discloses in which each buyer is represented by a software agent, each seller is represented by a software agent.

(figure 1 and column 8, lines 50-67, buyers represented by computers 122 and file server 116, sellers represented by servers 108; see column 13, lines 47-67, a buyer may define mutually exclusive groups of the same or similar products, column 18, lines 24-60, the buyer can enable this feature by specifying which of a plurality or currently ongoing negotiations should be part of a mutual exclusive group in which all negotiations are automatically terminated when an agreement in any one of the negotiation is reached).

Regarding to claim 8, Ojha further discloses comprising the use of an intermediate software agent between the buyers and the or each seller, for negotiating a contract between the or each seller and the collective buyers (figure 1 and column 8, lines 50-67, the web site at which transactions between buyers and sellers are facilitated is located on a server 102).

Claims 9, 10, 12 contain similar limitations found in claims 2-3 above, therefore, are rejected by the same rationale.

Regarding to claim 13, Ojha further discloses arranged to conduct an automated reverse auction on an electronic network using software agents for buyers and sellers (column 5, lines 40-55).

Regarding to claims 15-21, Ojha further discloses in which each software agent is a component of a distributed architecture (figure 1 and column 8, lines 50-67, servers 102, 108, 116).

Regarding to claim 22, Ojha does not disclose the software is implemented as FIPA open source. However, implementing a software as FIPA open source is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the

art at the time the invention was made to modify Ojha's to adopt the well known feature above for the purpose of performing automated reverse auction.

Regarding to claims 23-24, Ojha further discloses a communications network comprising a system according to claim 27, in which the network consists of the Internet (figure 1 and column 7, lines 35-45).

Regarding to claims 25-26, Ojha further discloses computer program for creating a system according to claim 27, a computer program for creating a software agent according to Claim 2 (column 22, line 53-column 23, line 12).

Regarding to claims 27-28, Ojha discloses a system and method for performing automated reverse auction comprising the steps of:

a first software agent (figure 1 and column 8, lines 50-67, the web site at which transactions between buyers and sellers are facilitated is located on a server 102), comprising: a store of a plurality of negotiation profiles each negotiation profile determining different negotiation characteristics and requirements (column 15, lines 30-65, the seller authorizes automated response to bids by specifying a number of business rules to govern the responses, for each rules, the seller defines a set of criteria and set of actions to be taken when the set of criteria is satisfied, the number of criteria may be defined and combined in variety of ways using logical operators and groupings); a transaction engine responsive to the commercial situation or state of the party to select an optimal negotiation profile appropriate to that situation or state (column 9, lines 15-18, a series of graphical user interfaces which will be used to illustrate the transaction process); a negotiation engine driven by the transaction engine that is above

to generate bids and counter bids (figures 15-17 and column 18, lines 30, a series of graphical user interfaces allow buyers and sellers submit bids and counteroffers); and control means adapted to cause the transaction engine to initiate or conduct e-commerce negotiations using the negotiation engine programmed with the selected negotiation profile, receiving a request for a service from a buyer (figures 13A-13K and column 15, line 30-column 16, line 67, the business rules associated with each seller is equivalent to negotiation profiles, the seller authorizes automated responses to bids by specifying a number of business rules to govern the responses);

the first software agent requesting negotiation for provision of the service with at least one other agent (figure 16, the user interface allows the buyer to submit bids and counteroffers to the sellers); and

the first software agent responding to a proposal for providing provision of the service from a second agent (figure 17, the user interface allows the seller submit response or counteroffers to the buyer).

Ojha does not disclose a mapping for converting qualitative attributes for a part of a bid into numerical values and a weighting factor for each part of a bid and compute a single value for a bid by adjusting the numerical value using the weighting factor and summing the adjusted values, the single numerical value being used to determine whether to accept the bid or not. However, Solomon discloses a mapping for converting qualitative attributes for a part of a bid into numerical values and a weighting factor for each part of a bid and compute a single value for a bid by adjusting the numerical value using the weighting factor and summing the adjusted values, the single numerical value

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being used to determine whether to accept the bid or not (see figure 4 and column 4, line 33-column 5, line 35). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ojha's to adopt the teaching of Solomon above for the purpose of providing more efficiency in performing automated reverse auction.

### ***Conclusion***

8. Claims 2, 3, 5, 8-10, 12, 13, and 15-28 are rejected.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 273-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:


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(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label  
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany  
Street, Alexandria, VA, First Floor (Receptionist).

  
NGA NGUYEN  
PRIMARY EXAMINER

August 1, 2006